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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,804	09/24/2001	Mari Kurosawa	SHI-015-USA-	8914

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EXAMINER
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WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,804

Applicant(s)

KUROSAWA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-6 are pending. The Amendment filed 9/12/03, Paper No. 16, amended claims 1-4 and added claims 5-6.

#### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/03 has been entered.

#### *Claim Rejections - 35 USC § 112*

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(i) The phrase "having a regular reflection percentage of 1% or less in an amount of 1-100wt.%" and the phrase "at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%" in claims 1, 5, and 6 are new. Specifically, the phrase "regular reflection" is new, as is a "percentage of 1% or less". Defining the diffuse reflection percentages as more than 5%, in an amount of less than 10wt.%, is also new.

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Regarding this rejection, Applicant argues, "The reflection-minimized powder is described in detail in the Specification on page 44, lines 20-27, and on page 50, line 18 to page 51, line 6. In order to avoid using the term "minimized", the reflection-minimized powder is defined as a first powder by using regular reflection percentage and diffuse reflection percentage in claim 1". This argument is not persuasive. The Examiner respectfully points out that the phrase "reflection-minimized powder" does not give support to the phrase "regular reflection".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "a second powder, at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%, on the basis of the entirety of the finishing composition" in claims 1 (part ii), 5 (part ii), and 6 (part ii), is vague and indefinite, as it is confusing. Does the recited percent weight refer to the amount of second powder in the finishing composition or does the recited percent weight refer to the regular reflection percentages and the diffuse reflection percentages?

(ii) The term "low" in claim 6 (line 4) is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Note: The term "powder" is misspelled in claim 5, last line of (A).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-128122 in view of JP 9-194323.

The instant invention is directed to a kit containing (A) a first layer foundation composition and (B) a second layer finishing composition, wherein the first layer contains a silicone oil, a polyether-modified silicone represented by the formula in instant claim 1, water, and a hydrophobic powder, a second layer finishing composition containing a first powder and a second powder.

JP '122 is directed to makeup compositions comprising a first layer foundation composition and a second layer finishing composition (summary at page 3). The second layer composition comprises a diffuse reflection powder such as methyl methacrylate, nylon and polyethylene, inter alia (sections 0018 to 0019 at page 10) in an amount from 5-100 wt.% (section 0022 bridging pages 11 and 12). For a second layer finishing composition containing spherical nylon powder see sections 0028-0029 at pages 14-15. The powders disclosed by JP '122 for use in the second layer composition are the same disclosed by Application as providing minimized regular reflection and diffuse reflection. See the instant specification at page 51, paragraph 2 for polymethyl methacrylate, polyethylene and nylon powders. For a first layer foundation composition containing silicone oil with a viscosity of 1cs and 20cs, see Example 3 at

page 18. The reference does not teach a first layer foundation composition containing a polyether-modified silicone, water and a hydrophobic powder in addition to the silicone oil, and does not explicitly recite a kit.

JP '323 teaches a cosmetic composition containing a silicone oil, a polyether modified silicone of the formula instantly claimed, water and hydrophobic powder (page 3). For a make-up foundation composition containing the components instant claimed see Example 8 at page 22. For silicones oils containing 20-80% of the composition, for polyether modified silicones comprising 2-30% of the composition, for water comprising 0.2-80% of the composition, for hydrophobic powder comprising 1-60% of the composition, see claim 2. For powders with a refractive index of 1.3-2, see [0016]. The compositions of JP '323 provide light, refreshing feeling upon application without greasiness.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the foundation composition of JP '323 for the first layer foundation composition of JP '122 because of the expectation of achieving a foundation composition that imparts a light, refreshing feeling without greasiness, to the skin of a user.

Regarding the limitation of a kit, the Examiner respectfully points out that a composition must be contained, and that a product containing two separate compositions, as taught by both references, must be contained such that the product has two separate entities wherein the two compositions maintain their individuality. Thus, while JP '122 and JP '323 do not explicitly teach a kit, a kit is suggested. Furthermore, one of ordinary skill in the art would be motivated to generate a kit because of the ever present need to contain a single foundation product in a container wherein the fluid composition and the powder composition are joined.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '122 in view of JP '323 as applied to claims 1-5 above, and further in view of Miyazawa et al. (6,326,011).

JP '122 and JP '323 are applied as discussed above. The reference lacks siliconated polysaccharide.

Miyazawa et al. teach siliconized polysaccharide as film-forming ingredients for use in cosmetic compositions. See Col. 10, lines 38-Col. 12, line 31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the siliconized polysaccharide taught by Miyazawa et al. to the first foundation layer of JP '122 because of the expectation of achieving a foundation with transfer-resistant properties, wherein the second layer can be applied without smearing the first layer.

#### ***Response to Arguments***

Applicant argues, "the cited '122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder, such as titanium oxide and mica, to no more than 10wt% of the finishing layer, provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin". This argument is not persuasive, as it is not commensurate in scope with the instant claims, which do not recite titanium oxide, mica, or a description of the effects of applying the composition to the skin.

Applicant argues, "JP '323. . . fails to teach a second layer finishing composition containing 1-100wt% of the reflection minimized powder and less than 10wt% of the reflection powder, as claimed herein". This argument is not persuasive. First, this argument is not commensurate in scope with the instant independent claims which do not recite a reflection

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minimized powder. Second, the Examiner respectfully points out that JP '323 is relied upon to teach the constituents of the first foundation layer and not the powders of the second foundation layer.

Applicant argues, "the reflection powder incorporated into the second layer of finishing composition is in an amount of 10.025% or less, as now claimed herein in amended Claim 1". This argument is not persuasive. For the reasons, stated above, this portion of the claim is vague and indefinite. Furthermore, it is respectfully pointed out that the percent weights taught by JP '122 overlap those recited in the instant claims.

Applicant argues, "It was unexpectedly discovered that a synergistic effect is obtained by the combination of the first layer foundation and the second layer finishing composition. . . a series of comparative tests. . . as outlined on page 61 of the Specification. The results of these tests may be found in Tables 2, 4 and 5 on pages 64, 66 and 69 of the Specification". This argument is not persuasive, as page 61, 64, 66, and 69 of the specification are not persuasive to show unexpected results. The Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).



Applicant argues, “the comparative tests show in Table 2 demonstrate the synergistic effectiveness of the compositions of the present invention as now claimed in concealing irregularities of the skin while imparting a natural appearance to the skin”. This argument is not persuasive. First, the Examiner respectfully points out that Table 2 is not commensurate in scope with the instant claims. Second, there is no comparative data with the closest prior art. Third, it is not known what the term “BB” stands for.

Applicant argues, “The test results shown in Table 4 of the tests comparing the comparative examples 1-3 to the compositions of the present invention clearly demonstrate that the compositions of the present invention provide much improved natural appearance over the compositions of the prior art”. This argument is not persuasive. First, it is respectfully pointed out that the comparative compositions are not the closest prior art. Second, the Examiner is not clear what the term “CC”, “DD”, “AA”, and “BB” stand for.

Applicant argues, “If the foundation composition of JP ‘323 is substituted for the first layer foundation composition of JP ‘122, a powdery appearance is imparted. Please see, in particular, combination 6 in table 5”. This argument is not persuasive. Again, the Examiner respectfully points out it is unclear what the terms “DD”, “CC”, “BB”, “AA”, stand for, and it is unclear what the terms “shadow”, “shadow, color”, and “color” mean in the context of Table 5. Additionally, it is unclear what the table means. What do the stars in “Combination 6” indicate? What does “L Ex (1)-(7)” mean? What does “P Comp. Ex. (1) (2)” mean? While these compositions can be found, it is not clear what this table is attempting to show.

Hence, Applicant’s data in the specification, it not clear to show unexpected results.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**  
10/19/05